

REMARKS

The present invention relates to a method for manufacturing bleached mechanical and chemithermolmechanical pulp.

It is appreciated that in the Examiner has recognized patentability and allowed claims 8-10.

However, claims 1 - 7 and 11 - 13 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness with respect to certain terminology in claim 1 and in claim 11. Particularly, the “the given drastic condition” and “the given minimize oxygen access” at lines 14 and 15 of claim 1 were said to lack sufficient antecedent basis. The Examiner also indicated concern regarding definiteness in claim 1 with respect to the terminology “or like means” with respect to “a steam separator” as a step in the method. With respect to claim 11, the terminology “very high” with respect to the temperature when bleaching” and the term “low” with respect to the solid content or concentration were considered to be indefinite.

With respect to the prior art, claims 1 - 7 and 11 - 13 were rejected under 35 U.S.C. § 103(a) in view of the previously cited alleged admitted prior art, the Madison reference, the West reference, and the Grimsley reference.

With respect to the rejection of claim 1 and the claims dependent thereon with respect to the quoted terminology in claim 1, first it is respectfully submitted that terminology such as “steam separator” and the like are well known to those skilled in the art. With respect to the two phrases that the Examiner stated lacked antecedent basis, the claim recitations have been amended in order to more clearly correspond to the conditions described in the specification, such as at page 11, lines 15 *et seq* and in the Examples. Applicant respectfully submits that the recitations set forth in amended claim 1 herein do have adequate antecedent basis in the specification, and would be definite in meaning to the person skilled in the art. If the Examiner may believe that some other recitation might be more appropriate, the Examiner is invited to contact the undersigned attorney to discuss any terminology that the Examiner may believe to be preferable.

With respect to claim 11, it must be noted that indication that the temperature is “very high” is qualified by the further recitation “from a bleaching aspect”, and the indication that the solid content or concentration is “low” at said location would be understood to be in the context of what would be normal at the location, referring, for example, to the specification at page 11, line 15 *et seq*, page 12, lines 7 *et seq*, and the Examples.

Accordingly, it is respectfully submitted that the present claims are in fact definite in meaning to a person skilled in this art, and comply with the requirements of 35 U.S.C. § 112.

With respect to the prior art rejection maintained with respect to claims 1-7 and 11-13 under 35 U.S.C. § 103(a) based on the asserted combination of alleged admitted prior art in view of the Madison reference, the West reference, and Grimsley et al reference, reconsideration is respectfully requested. It is respectfully submitted that the cited art would not, and in fact could not, be combined in the particular manner asserted to achieve the presently claimed invention as set forth in claims 1 - 7 and 11 - 13. It is only by hindsight reconstruction that such a conclusion can be reached.

The Examiner has referred to MPEP 2129 with respect to the consideration of what is admitted prior art based on the use of the Jepson claim format. However, the combination of known features with further features that have not been used together therewith previously can, and in the present case does, constitute a novel and unobvious combination.

It has been previously recognized in this case that the admitted prior art based on Jepson preamble recitation does not include disclosure of expressly adding bleaching agent at a location downstream of the most downstream refiner, and upstream of the screening department. Furthermore, it has been previously recognized that the bleaching of the pulp under the drastic conditions from the aspect of temperature and the given minimized oxygen access at the location and immediately downstream of the location are not known in the admitted prior art.

Then, with respect to the secondary and tertiary references cited in the Office Action, it has been previously recognized that the Madison et al reference does not disclose expressly bleaching the pulp under the claim-required drastic condition with respect to temperature and minimized oxygen access condition at the noted location and immediately downstream thereof, and that the West reference does not disclose expressly minimized oxygen access at the noted location and immediately downstream thereof. However, although assumptions must be made in order to rely on Madison et al in combination with the West reference as disclosing bleaching pulp under a drastic condition of temperature, the Office Action must furthermore rely on yet a third reference to provide a basis for all features recited in claim 1, viz., Grimsley et al, as disclosing minimized oxygen access at the noted location immediately downstream thereof.

What is still lacking, however, is an explanation as to how a person of ordinary skill in the art would be lead to choose just those selected features of the secondary and tertiary references, while ignoring other disclosure of those references, to arrive at the presently claimed invention as set forth in claims 1 - 7 and 11 - 13. That is, there is no basis for selecting the specific teachings that would lead a person of ordinary skill to subject matter of the rejected claims. Thus, it appears to require hindsight to reach a conclusion that claims 1 - 7 and 11 - 13 are obvious.

Accordingly, withdrawal of the rejection of the claims 1-7 and 11-13 is respectfully submitted to be proper.

In view of the foregoing amendments to the specification and claims, and foregoing remarks, Applicants respectfully submit that the present application, including not only claims 8 - 10, but also claims 1 - 7 and 11 - 13, is now in condition for immediate allowance.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby earnestly solicited.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local Washington, D.C. telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

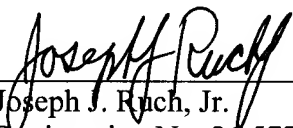
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER



Joseph J. Ruch, Jr.
Registration No. 26,577

Date: September 14, 2007